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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,365	03/12/2004	Shuichi Takamiya	018995-745	6077

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EXAMINER

CHU, JOHN S Y

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,365

Applicant(s)

TAKAMIYA, SHUICHI

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/30/04, 6/10/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is in response to the application filed March 12, 2004 and the election received July 29, 2005.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-6 further define the claimed alkylene oxide adduct, however the formulae defined as A and B fail to be consistent with the recited linear-type or branch-type alkylene oxide adduct. For example in claim 2 there are two choices for A and B. Here the groups are the following:  $-\text{CH}_2\text{CH}_2\text{O}-$  or  $-\text{CH}_2\text{CH}(\text{CH}_3)\text{O}-$  wherein if only the second group is selected for A and/or B, then the alkylene oxide adduct is no longer only a linear-type compound. Likewise claim 4 involves the same issues wherein if the first group is selected, then the compound is no longer a branch-type compound. Correction is necessary to set a condition wherein if a linear or branch type compound is being described, then the types of groups appropriate are singled out to be only selected to define A and/or B.

Second the term "type" in claim 1 for linear-type and branch-type is indefinite wherein it is unclear what the intended definition for linear-type and branch-type is meant to define. Is the linear alkylene oxide only linear or can it be a linear-type of compound including a percentage of branches? The same definition applies to a branch-type alkylene-oxide. Are the branched

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compounds inclusive of linear chains or just branches alone? Correction to the language is necessary in order to make the language definite.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over SASAYAMA et al (6,364,544 B1).

The claimed invention is drawn to the following:

1. An alkaline developing solution for development of a heat-sensitive presensitized plate of positive-working mode for use in making a lithographic printing plate, which developing solution comprises a linear-type alkyleneoxide adduct and a branched-type alkyleneoxide adduct.

SASAYAMA et al discloses an automatic developer apparatus and a developer used in the apparatus and a method of replenishing the replenisher for developer. Applicants are specifically directed to column 5, lines 55 – column 6, line 56 for the surfactants used in the developer composition. The nonionic surfactants disclosed in the reference include polyoxyethylene, polyoxypropylene and polyoxybutylene, as seen in column 6, lines 35-38, wherein SASAYAMA et al further disclose that the surfactants can be used individually or in combination. Here the disclosure clearly sets forth that more than one surfactant can be used in the developer composition such that more than one non-ionic surfactant can also be used to

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include a polyoxybutylene which include iso-butylene and tert-butylene groups which are branched. With this teaching the skilled artisan would be motivated to use more than one nonionic surfactant to include a linear or branched surfactant as suggested by SASAYAMA et al.

It would have been *prima facie* obvious to one of ordinary skill in the art of developer compositions to select more than one surfactant to be used in the developer, to include the isomers of polyoxybutylene with a second nonionic surfactant such as the convention polyoxyethylene alkyl ethers and reasonably expect same or similar results with respect to having a developer which forms sharp and clear images upon development.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. TAKAMIYA 6,919,166 B2 is cited of interest as not prior art due to the same inventive entity which excludes 102(b) and (e). In addition no ODP is made due to the differences as claimed wherein only a single surfactant is claimed and no suggestion for a linear and a branched alkylene oxide is recited.

EP-965,887 is cited of interest to the same assignee and is cumulative as to the disclosure in SASAYAMA et al.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John S. Chu  
Primary Examiner, Group 1700

J.Chu  
October 15, 2005